

**REMARKS**

Claims 1-37 are pending in this application. By this Amendment, claims 1, 14 and 26 are amended. No new matter is added. Reconsideration in view of the foregoing amendments and remarks are respectfully requested.

Applicants thank Examiner Guyen and Bashore for the courtesies extended to Applicants' representatives during the December 22 personal interview. During the interview, the Examiners suggested to amend the claims for better clarity. This Amendment makes such amendments.

The Office Action rejects claims 1-37 under 35 U.S.C. §103(a) over U.S. Patent No. 6,173,287 to Eberman et al. (Eberman) in view of "Beyond Paper: Supporting Active Reading with Free From Digital Ink Annotations" to Schilit et al. (Schilit). This rejection is respectfully traversed.

The invention is directed to an annotation device that can operate to annotate a document while the document is viewed from a separate device (for example, a paper version of document). That is, as described in the specification at, for example, page 1, line 15 to page 2, line 30, a user can makes annotations for an object (e.g., a hard copy of a document) using an annotation device (e.g., a hand-held device) while actually looking at the object separately from the annotation device (i.e., viewing the hard copy object while making annotations on the annotation device separate from the hard copy object). This allows the user to keep the high resolution, portable nature and tangibility of the document, while utilizing the connectivity and portable nature of the hand-held device. When the annotation device synchronizes the annotation with the object, the annotations are transferred to the object by associating the annotation with portions of the object based on an object identifier.

Claim 1 is amended for better clarity and recites, *inter alia*, that a user makes annotation using an annotation device while viewing an object using a distinct viewing device, and that upon synchronization, the annotation is transferred to the object.

Applicants respectfully submit that none of the applied prior art recognizes the above-described feature of making annotations using an annotation device while viewing the object by a distinct viewing device. For example, the device taught by Schilit allows the user to make annotations directly on the document. See Figure 1. However, in the claims, the annotation is separate from the document (object) and later linked and synchronized to the document. Moreover, as discussed during the interview, none of the applied prior art teaches or suggests that annotations are transferred to the object by associating the annotation with the object based on a link and an object identifier.

In addition, the Office Action asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schilit with Eberman because it would have provided the capability for allowing the users to create and view the annotations in different media. Applicants respectfully assert that this statement is merely a conclusive result of combining the references, and that the Office Action does not provide any motivations for one of ordinary skill in the art to combine the references. Therefore, the Patent Office fails to meet basic requirements of a *prima facie* case of obviousness. See, M.P.E.P. §2143.

In addition, as described above, neither Eberman nor Schilit teaches or suggests the features and advantages of the claimed invention. Since the only disclosure of such features and advantages is in Applicants' disclosure, it is evident that the Office Action's assertion impermissively relies on hindsight knowledge gained from Applicants' disclosure. Accordingly, this rejection by the Patent Office is improper.

Furthermore, the Office Action asserts that Schilit discloses a viewing devices distinct from an annotation device. Applicants respectfully disagree.

As discussed during the interview, Schilit teaches Xlibris that supports a multiple navigation mechanisms including a "Reader's Notebook," with which the users can review, assort and filter clippings of their annotated text. See Abstract. The "Reader's Notebook" is a notebook of clippings derived from reader's annotations (page 253, right column, last paragraph) and extracts annotated clippings and lays them end-to-end in a separate, multi-page view (page 254, left column, first paragraph). As discussed during the interview, Applicants respectfully submit that there is no teaching or suggestion that this "Reader's Notebook" is a part of Schilit's device and clearly is not a viewing device that is distinct from an annotating device. Accordingly, even if combined, Eberman and Schilit do not achieve the claimed invention. As such, Applicants respectfully submit that claim 1 is patentably distinct from the applied prior art.

Independent claims 14 and 26 recites features similar to claim 1. Accordingly, claims 14 and 26 are also patentably distinct from the applied prior art.

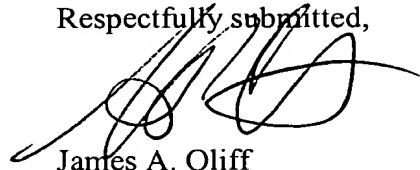
Dependent claims 2-13, 15-25 and 27-37 are allowable at least for their dependence on allowable base claims.

At least for the reasons described above, Applicants respectfully request withdrawal of this rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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